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| 09/724,744 | 11/28/2000 | John Thaddeus Pienkos | | 8432 |

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3625

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-----------------|------------------------|--|
| Application No. | Applicant(s) | |
| 09/724,744 | PIENKOS, JOHN THADDEUS | |
| Examiner | Art Unit | |
| James H. Zurita | 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6 May 2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

On 28 November 2000, applicant filed the instant application, claiming priority to provisional application 60/190770, filed on 20 March 2000.

On 30 September 2003, the Office issued an Election/Restriction Requirement.

On 31 October 2003, applicant filed an amendment, canceling claims 18-20, adding claims 21-23.

On 8 March 2004, the Examiner issued a non-final rejection of claims 1-17 and 21-23 as unpatentable over ***Business Wire*** (04/22/99), *Swiss RE Develops Patent Validity Insurance for Patent and License Exchange*, 2 pages, in view of an article by Margaret ***Quan***, *Intellectual Property Exchange Takes Off*, published on 10 March 2000 in EE Times, 1 page.

On 13 October 2004, applicant filed a response.

On 20 September 2004, the application mistakenly became abandoned for failure to respond to an office action.

On 22 October 2004, the Office mailed a notice of rescinded abandonment, on the basis of applicant's response of 13 October 2004.

On 27 December 2004, the Examiner mailed a final rejection, again rejecting claims 1-17, 21-23 as unpatentable over ***Business Wire*** (04/22/99) in view of ***Quan***.

On 27 December 2003, the Examiner issued a final rejection of claims 1-17, 21-23. The final rejection was mailed on 3 January 2005.

On 6 May 2005, applicant requested continued Examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 May 2005 has been entered.

Response to Amendment

On 3 May 2005, applicant cancelled pending claims 1-17 and 21-23. Applicant added claims 24-43.

Claims 24-43 are pending and will be examined.

Response to Arguments

Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically

pointing out how the language of the claims patentably distinguishes them from the references.

Claim Objections

The following claims are objected to because of informalities:

Claims 24-42 refer to various proposed agreements and various transactions and will be interpreted as follows. The proposed agreement of claims 24-32 appears to be an agreement between IPIB and a prospective buyer, i.e., IP Desirer. This agreement appears to correlate to the second agreement of claims 35-42. The "...additional..." proposed agreement of claim 33 appears to refer to an agreement between a prospective seller, i.e., IP Owner and the IPIB. This agreement appears to correlate to the first agreement of claims 35-42.

Claims 24-32 refer to a transaction between IPIB and a prospective buyer, while the "...additional..." transaction of claim 33 appears to refer to a transaction between a prospective seller, i.e., IP Owner, and the IPIB.

Claims 27 and 35 use "...automatic..." which renders the claims indefinite. The term will be interpreted as being performed by a computer, such as by printing.

Claims 35-42 refer variously to "...[##] interest ..." "...[##] interest in an ***intellectual property***..." "...[##] interest in an intellectual property ***asset***..." The terms will be interpreted as synonyms.

Claims 37 and 38 refer to "...any transfer pertaining to the intellectual property asset." Other claims refer to "...transfer ***of interest*** in an ..." The Examiner notes that all transfers are transfers of interests. Claims 37 and 38 will be interpreted accordingly.

Claim 37 refers to "...concerning a requirement of the first party..." the term will be given its broadest reasonable interpretation to refer to rules and controls set up by IP Owners.

Claim 43 reads "...wherein the second interest at least one of encompasses and is identical to the first interest;" It is not clear what is being conveyed. For purposes of this examination, the term will be interpreted to mean that the party sells the rights it purchased.

Claim 43 refers to an "...exchange..." An exchange is a place where things are or services are exchanged.¹ For purposes of this Examination, the term "...intellectual property exchange..." will be interpreted as a centralized distribution system for intellectual property where creators, providers and users may exchange content and associated content control sets.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

¹ Definition of *exchange*, MERRIAM WEBSTERS Collegiate Dictionary

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 34 refers to transfer of interest in a property asset where the property asset is a real property asset. Real property is land and generally whatever is erected or growing or affixed to land.² Applicant mentions real property once, on page 44, line 23, but does not provide any description of how to apply his invention to transfer of interests particular to real property.

Claim Rejections

Claims 24-42 refer to various parties. The Examiner notes that, for different sets of claims, applicant appears to mix the various labels and corresponding parties and sets of data. While a label does not by itself provide patentable distinction, the following appear to reflect applicant's latest nomenclature.

| | CI 24-34 | cl. 35-42 | cl. 43 |
|--------------|---------------------|----------------------|-------------------|
| First party | IPIB | IP owner | IP owner |
| Second party | IP Desirer | IP Desirer | IP Desirer |
| Third party | IP owner | IPIB | IPIB |
| Fourth party | | | IP Exchange |

The following is a list of rejections in this Office Action:

| claims | 35 USC | references |
|-------------------------------|---------------|----------------------------|
| 24, 25, 27, 32, 33, 35-38, 42 | 102(e) | Ginter |
| 26, 43 | 103(a) | Ginter |
| 34 | 103(a) | Ginter in view of Ashenmil |
| 28-31, 39-41 | 103(a) | Ginter in view of plx |

² Definition of ***real property***, Blacks Law Dictionary.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 24, 25, 27, 32, 33, 35-38, 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (US 5892900).

For transfer of rights see at least Col. 180, lines 3-24, Col. 278, line 59-Col. 279, line 5, Col. 341, line 54-Col. 342, line 54. See also Fig. 2A and related text.

As per claim 24³, Ginter discloses Internet-based execution of transactions involving transfer of interests in property assets, such as copyright, distribution and usage of software, music, books, etc., as in Col. 141, lines 4-33.

³ For claims 24-34, applicant appears to use the following labels:

- First party (IPIB 110) is Ginter's Rights Distributor 106.
- Second party (IP Desirers 130) is Ginter's Content User 112.
- Third Party (IP Owners 120) is Ginter's Content Creators 102, as in claim 33.

The transactions may take place over the Internet. See, for example, at least Col. 37, line 15-Col. 38, line 35, Col. 307, lines 6-23.

The transactions may involve multiple parties, including applicant's first party (VDE Rights Distributor 106), second party (VDE Content User 112) and third party (VDE Content Creators 112). The transactions involve transfers of rules and control, as illustrated in Fig. 2 and explained in related text.

(a) **receiving** at a computer system of the first party (VDE Rights Distributor 106), from the second party (VDE Content User 112) via the Internet, first information regarding a nature of the property asset. *First information* may include, for example, titles, abstract information, relevant dates, and others, used for searches by end users, as in Col. 310, lines 23-32. See also Col. 317, lines 14-43, concerning requests by an end user for particular content. See also Col. 110, lines 16-25, concerning different ways of searching for information concerning assets, including search by abstract information, summaries of content. See also Col. 200, lines 36-54, concerning search indices, tables of content.

(b) **obtaining** at the computer system (VDE Rights Distributor 106) second information regarding at least one restriction concerning the property asset. See, for example, transfer restrictions, as may be found in permissions records 808, Fig. 5B.

(c) **providing** a proposed agreement onto the Internet regarding the transfer of the interest in the property asset from the first party (VDE Rights Distributor 106) to the second party (VDE Content User 112), wherein the agreement is reflective of the at least one restriction concerning the property asset. See, for example, Col. 269, line 15-Col. 270, line 37.

(d) **receiving** an indication of acceptance of the proposed agreement by the second party (VDE Content User 112), whereby the transaction involving the transfer of the interest in the property asset between the first party (VDE Rights Distributor 106) and second party (VDE Content User 112) is executed. See at least Col. 269, line 15-Col. 272, line 22.

As per claim 25, Ginter discloses the property asset is an intellectual property asset. See, for example, at least Col. 43, lines 21-42, concerning Intellectual property rights in copyrighted software, music, books. See also at least Col. 141, lines 4-33.

As per claim 27, Ginter discloses the proposed agreement is at least partly generated in an automatic manner. See at least Col. 39, lines 4-41, Col. 47, lines 21-55, Col. 273, lines 40-52, Col. 319, lines 36-55, Col. 322, lines 15-29, Col. 329, line 46-Col. 330, line 8.

As per claim 32, Ginter discloses receiving at the computer system (VDE Rights Distributor 106) via the Internet, third information regarding a bid price for the interest in the property asset. See, for example, references to bidding, as in Col. 2, lines 32-56, Col. 9, lines 46-57, Col. 270, line 39-Col. 274, line 51, Col. 308, lines 36-61.

As per claim 33, Ginter discloses prior to step (a) of claim 24, the following may take place. Please note that the following steps are the basis for later distribution of works of content creators.

(a) **receiving** at the computer system (VDE Rights Distributor 106) from the Internet, at least one of the first information (e.g., *First information* may include, for example, titles, abstract information, relevant dates, and others, used for searches by end users, as in

Col. 310, lines 23-32) and third information (e.g., price, as in Col. 55, line 61-Col. 56, line), regarding the nature of the property asset.

(b) *providing* an additional proposed agreement (i.e., an agreement between VDE Rights Distributor 106 and VDE Content Creator 102) onto the Internet regarding an additional transfer of at least one of [the interest in the property asset and an additional interest in the property asset]. See, for example, at least Col. 56, lines 12-24, concerning rules and controls that VDE Content Creators may impose on their copyrighted works. These rules and conditions are the basis for agreement on how their works may be distributed. See at least uploading of rules and controls, Col. 56, lines 6-25.

(c) *receiving* an indication of acceptance of the proposed agreement by a third party (VDE Content Creator 102) (VDE Content Creators 102) whereby an additional transaction involving the property asset is executed between the first and third parties, so that the first party (VDE Rights Distributor 106) obtains the interest in the property asset that is subsequently transferred to the second party (VDE Content User 112). See, for example, Col. 47, lines 21-55. See also Col. 269, line 15-Col. 270, line 37.

As per claim 35⁴, Ginter discloses method(s) of facilitating a transfer of a first interest in an intellectual property asset between first party (VDE Content Creator 102) and second parties (VDE Content User 112) by way of a third party that is a IPIB (VDE Rights Distributor 106). Ginter discloses:

⁴ In Claims 35-42, applicant uses the following labels for the various parties:

- First Party (IP Owners 120), is Ginter's Content Creator 102.
- Second Party (IP Desirers 130), is Ginter's Content User 112.
- Third Party (IPIB 110) is Ginter's Rights Distributor 106.

(a) **transferring** a second interest in the intellectual property asset from the first party to the IPIB by concluding a first agreement between the first party and the IPIB (VDE Rights Distributor 106), wherein due to the transferring of the second interest the IPIB (VDE Rights Distributor 106) obtains at least one of an ownership stake in the intellectual property asset and a license to the intellectual property asset. This claim is rejected on the same grounds as claim 33(b).

(b) **transferring** the first interest in the intellectual property asset from the IPIB (VDE Rights Distributor 106) to the second party (VDE Content User 112) by concluding a second agreement between the second party (VDE Content User 112) and the IPIB (VDE Rights Distributor 106), wherein the second interest at least one of encompasses and is identical to the first interest. This claim is rejected on the same grounds as claim 33(c).

(c) wherein each of the first and second agreements is at least partly generated in an automatic manner based upon information received by the third party IPIB (VDE Rights Distributor 106) from the first party (VDE Content Creator 102) and second party (VDE Content User 112). See at least Col. 269, line 15-Col. 270, line 38.

As per claim 36, Ginter discloses that the IPIB (VDE Rights Distributor 106) generates and provides at least one of the first and second agreements to at least one of the first party and second party via the internet. (see, for example, at least Col. 37, line 15-Col. 38, line 35, Col. 307, lines 6-23). See also Fig. 2, related text concerning rules and controls 104 and 110.

As per claim 37, Ginter discloses prior to transferring of the second interest:

(a) **receiving** first information at the IPIB (VDE Rights Distributor 106) from the first party (VDE Content Creator) concerning a nature of the intellectual property asset. This claim is rejected on the same grounds as claim 33(a).

(b) **receiving** second information at the IPIB (VDE Rights Distributor 106) from the first party concerning a requirement of the first party (VDE Content creator) in relation to any transfer pertaining to the intellectual property asset. See, for example, at least Col. 55, line 54-Col. 56, line 62.

As per claim 38, Ginter discloses subsequent to the transferring of the second interest but prior to the transferring of the first interest:

(a) **receiving** first information at the IPIB (VDE Rights Distributor 106) from the second party (VDE Content User 112) concerning a desired nature of the intellectual property asset. See claim 24(a) for rejection.

(b) **receiving** second information at the IPIB (VDE Rights Distributor 106) from the second party (VDE Content User 112) concerning a restriction of the second party (VDE Content User 112) in relation to any transfer pertaining to the intellectual property asset. Please refer to claim 24 (b) and 24(c) for rejection.

As per claim 42, Ginter discloses that the computer system of the IPIB (VDE Rights Distributor 106) is configured to conduct communications with computer systems associated with each of the first party (VDE Content Creator) and second party (VDE Content User 112) by way of the Internet, and wherein the computer system of the IPIB (VDE Rights Distributor 106) performs processing based upon the first information. See, for example, at least Col. 37, line 15-Col. 38, line 35, Col. 307, lines 6-23.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 26 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Ginter*** et al. (US 5892900).

As per claim 26, Ginter discloses the first party (VDE Rights Distributor 106) may own interest in the property asset prior to the transaction being executed. See various types of interests, as in Fig. 2A and related text. As per claim 26, Ginter ***does not*** use the label "...intellectual property investment bank..."

However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as *Ginter* because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

As per claim 43⁵, an exchange is a place where things are or services are exchanged.⁶ Ginter discloses that content may be sold and resold along value chains and chains of handling. See, for example, references to six agreements in an extended agreement for a particular value chain instance. See also at least Col. 5, lines 14-45, which discloses that participants of the distribution can freely exchange content and associated control sets, corresponding to applicant's "...intellectual property exchange..."

Ginter discloses method(s) of facilitating exchanging first interest in an intellectual property between first party (VDE Content Creators 102) and second parties (VDE Content User 112) by way of a third party that is an *IPIB* (VDE Rights Distributor 106) and any one of additional parties, including applicant's "...Intellectual Property Exchange..." See rejection of claims 24 and 25. For roles of one or more intermediaries, please see at least Figs. 80-87. For ClearingHouse, please refer to Fig. 87, reference 116. Transfer of interests among the parties is accomplished via negotiated contracts, as in Col. 259, line 15-Col. 260, line 36.

Ginter **does not** provide specific examples of Set (a) or set (b), listed in Claim 43. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Ginter to disclose (i) transferring a second interest in the intellectual property asset from the first party to the *IPIB* so that the *IPIB* obtains the second interest in the intellectual property asset, wherein the second interest at least one

⁵ **Claim 43 appears to be directed to the following parties:**

First Party (IP Owners 120), Ginter's Content Creator 102
Second Party (IP Desirers 130), Ginter's Content User 112
Third Party (*IPIB* 110), Ginter's Rights Distributor 106.
Fourth Party appears to be IP Exchange 140.

of encompasses and is identical to the first interest; (ii) providing first information regarding the intellectual property asset from the IPIB to the intellectual property exchange; (iii) receiving a first bid from the second party concerning the first interest in the intellectual property asset via the intellectual property exchange; and (iv) executing a first agreement between the IPIB and the second party so as to transfer the first interest in the intellectual property asset from the IPIB to the second party.

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Ginter to disclose (i) transferring a second interest in the intellectual property asset from the first party to the IPIB so that the IPIB obtains the second interest in the intellectual property asset, wherein the second interest at least one of encompasses and is identical to the first interest; (ii) providing first information regarding the intellectual property asset from the IPIB to the intellectual property exchange; (iii) receiving a first bid from the second party concerning the first interest in the intellectual property asset via the intellectual property exchange; and (iv) executing a first agreement between the IPIB and the second party so as to transfer the first interest in the intellectual property asset from the IPIB to the second party for the obvious reason that this allows multiple parties to partake in a chain of value to use the intellectual property.

Ginter **does not** use the labels "...intellectual property investment bank..." and "...intellectual property exchange..."

However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little

⁶ Definition of *exchange*, MERRIAM WEBSTERS Collegiate Dictionary

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or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as *Ginter* because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Ginter et al.* (US 5892900) in view of *Ashenmil* (US 6615187):

As per claim 34, *Ginter* **does not** specifically disclose that an asset can be real property asset. *Ashenmil* discloses methods for transferring interests in real estate that find equivalents in transfer of interests in intellectual property environment. See, for example, at least Col. 5, lines 48-62. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine *Ginter* and *Ashenmil* to disclose that property assets may be real property. One of ordinary skill in the art at the time the invention was made would have been motivated to combine *Ginter* and *Ashenmil* to disclose that property assets may be real property for the obvious reason that principles discussed by *Ashenmil* may apply equally as well to real estate and intellectual property.

Claims 28-31, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter et al.** (US 5892900) in view of **plx**, The Patent and License Exchange FAQ sheet, copyright 1999.

As per claims 28 and 39, Ginter **does not** specifically disclose that the property asset is a patent.⁷ This is disclosed by **plx**. It would have been obvious to one of ordinary skill in the art to combine Ginter and **plx** to disclose intellectual property such as patents. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Ginter and **plx** to disclose intellectual property such as patents because patents are another valuable asset that can be searched, licensed and sold according to negotiation and executed via electronic contracts. It would have been obvious to include transfer of interests in other types of intellectual property, including patents.

As per claims 29 and 40, Ginter **does not** disclose the first information regarding the patent includes at least one of a patent number, a filing date of the patent, an issue date of the patent, a technical subject matter of the patent, and a market with respect to which the patent is applicable. This is disclosed by **plx**, second paragraph, concerning patent information that is available by searching through market information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter and **plx** to disclose that a first information regarding the patent includes at least one of a patent number, a filing date of the patent,

⁷ Applicant's definition of intellectual property asset includes patents, copyrights and trademarks. Page 8, lines 15-18.

an issue date of the patent, a technical subject matter of the patent, and a market with respect to which the patent is applicable.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Ginter and *plx* to disclose that a first information regarding the patent includes at least one of a patent number, a filing date of the patent, an issue date of the patent, a technical subject matter of the patent, and a market with respect to which the patent is applicable for the obvious reason that such parameters permit a more rapid search for relevant intellectual property. For example a person specializing in one type of art may find it easier to search for patents in his area by having the information indexed according to technical subject matter, market and date patents were issued.

As per claim 30 and 41, Ginter ***does not*** disclose that second information includes at least one of an indication of whether the second party (VDE Content User 112) wishes to fully purchase the patent; an indication of whether the second party (VDE Content User 112) wishes to license the patent; and indication of whether the second party (VDE Content User 112) wishes to receive an exclusive license to the patent; an indication of whether the second party (VDE Content User 112) wishes to receive a nonexclusive license to the patent; an indication of a time period during which the second party (VDE Content User 112) wishes to license the patent; an indication of a geographical region with respect to which the second party (VDE Content User 112) wishes to license the patent; an indication of whether there are limitations on sublicensing of the patent by the second party (VDE Content User 112); an indication of whether there is a field of use restriction in relation to licensing of the patent; an indication of a royalty

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rate pertinent to licensing of the patent; and an indication confirming ownership of the property asset by the first party. This is disclosed by *plx*, third paragraph, which discloses that patents may be licensed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter and *plx* to include indications concerning a type of transfer, such as licensing. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Ginter and *plx* to include indications concerning a type of transfer, such as licensing for the obvious reason that a holder of a patent may wish to continue to own a lucrative source of income and make it available to more than one user.

As per claim 31, Ginter discloses that second information is received off of the internet at the computer system. See, for example, at least Col. 37, line 15-Col. 38, line 35, Col. 307, lines 6-23.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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22 July 2005

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